

ISSUE BATCH NO. S29 #53  
NOTICE OF ALLOWANCE DATE: 11/5/93  
SERIAL NO. 07/130,070 B. White  
4-21-94

**IN UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	David C. Ward et al.	)	
Serial No.:	07/130,070	)	Group Art Unit: 1807
Filed:	December 8, 1987	)	Examiner: Ardin Marschel, Ph.D
Title:	METHOD OF USING LABELED	)	
	NUCLEOTIDES (AS AMENDED)	)	

575 Fifth Avenue (18th Floor)  
New York, New York 10017  
March 22, 1994

**FILED IN PERSON**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**ATTENTION: MRS. TONI HOOD**  
**DRAWINGS PROCESSING DIVISION**  
**PK-3 - ROOM 915**  
**2231 CRYSTAL DRIVE**  
**ARLINGTON, VA 22202**

**COMMUNICATION IN CONNECTION**  
**WITH JANUARY 19, 1994 FILING**

Dear Sir or Madame:

This Communication follows a March 21, 1994 telephone conversation between Mrs. Toni Hood, Drawings Processing Division, Issue Branch, U.S. Patent and Trademark Office, and Applicants' undersigned attorney of record in connection with the above-identified allowed application, and more particularly, with the payment of the base issue fee and the filing of an Amendment Under 37 C.F.R. §1.312(a) on January 19, 1994.

Earlier this month the undersigned had voiced some concern to Mrs. Hood over the possible delay in processing the application to its issuance. Mrs. Hood kindly indicated that she would attempt to locate the file and determine the present status of the application.

Upon review of the file, Mrs. Hood relayed some information to the undersigned regarding the mis-debiting of the base issue fee to the assignee's Deposit Account No. 05-1135 and the inadvertent issuance of a Notice of Abandonment on March 18, 1994, which Notice was subsequently rescinded, according to Mrs. Hood. Mrs. Hood also indicated that the Rule 312 Amendment was not in the file.

Enz-1 (Div. III)

David C. Ward et al.  
Serial No. 07/130,070  
Filed: December 8, 1987  
Page 2 (Communication in Connection With January 19, 1994 Filing)

In response and further to the March 21st telephone conversation, Applicants, through their attorney, are submitting herewith a copy of the January 19, 1994 filing including the following as attached exhibits:

January 19, 1994 Communication                      Exhibit I

Base Issue Fee papers                                      Exhibit II

Amendment Under 37 C.F.R. §1.312(a)                      Exhibit III

Express Mail receipt and stamped  
return postcard indicating  
receipt by the USPTO mailroom  
on January 19, 1994                                      Exhibit IV.

Applicants and their undersigned attorney sincerely appreciate the diligence and efforts of Mrs. Hood in her thorough investigation of this matter, which hopefully will be resolved very shortly by the prompt mailing of an Issue Fee Notification.

No fee is believed due in connection with this Communication.

If it would be helpful in processing this application to issue, the undersigned invites a telephone call. His telephone number is (212) 856-0876.

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicants

ENZO DIAGNOSTICS, INC.  
c/o Enzo Biochem, Inc.  
575 Fifth Avenue (18th Floor)  
New York, New York 10017  
Tel. (212) 856-0876

Exhibit I

ISSUE BATCH NO. S29  
NOTICE OF ALLOWANCE DATE: 11/05/93  
SERIAL NO. 07/130,070

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David C. Ward et al.	)	
Serial No.: 07/130,070	)	Group Art Unit: 1807
Filing Date: December 8, 1987	)	Examiner: Ardin Marschel, Ph.D
For: METHODS OF USING LABELED NUCLEOTIDES (AS AMENDED)	)	

575 Fifth Avenue (18th Floor)  
New York, New York 10017  
January 19, 1994

FILED BY EXPRESS MAIL

**COPY**

Hon. Commissioner of Patents & Trademarks  
Washington, D.C. 20231

Attention: BOX ISSUE FEE

COMMUNICATION

Dear Sirs:

In connection with the above-identified application (now allowed), payment of the Base Issue Fee is made by return of the forms PTOL-85B and PTOL-85C herewith, authorizing payment of the necessary fee(s) from Deposit Account No. 05-1135.

Concurrently being filed with the payment of the Base Issue Fee is an Amendment Under 37 C.F.R. §1.312(a).

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicants

Enclosures:  
PTOL-85B  
PTOL-85C

ENZO DIAGNOSTICS, INC.  
c/o Enzo Biochem, Inc.  
575 Fifth Avenue (18th Floor)  
New York, New York 10017  
Tel. (212) 856-0876

Enz-1 (DIV. III)

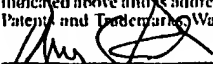
EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	<u>IB329026676</u>
Deposit Date	<u>JANUARY 19, 1994</u>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patent and Trademark, Washington DC 20231	
 Ronald C. Fedus Reg. No. 32,567	<u>JANUARY 19, 1994</u> Date

Exhibit.

II

## PART B—ISSUE FEE TRANSMIT

**MAILING INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE. Blocks 2 through 6 should be completed where appropriate. All further correspondence including the Issue Fee Receipt, the Patent, advances orders and notification of maintenance fees will be mailed to addressee entered in Block 1 unless you direct otherwise, by: (a) specifying a new correspondence address in Block below; or (b) providing the PTO with a separate "FEE ADDRESS" for maintenance fee notifications with the payment of Issue Fee or thereafter. See reverse for Certificate of Mailing.

1. CORRESPONDENCE ADDRESS		2. INVENTOR(S) ADDRESS CHANGE (Complete only if there is a change)	
DAVID A. KALON LILPERMAN & NOMANIDES ASSOCIATES 292 MADISON AVE., 8TH FLOOR NEW YORK, NY 10017		INVENTOR'S NAME	
		Street Address	
		City, State and ZIP Code	
		CO-INVENTOR'S NAME	
		Street Address	
		City, State and ZIP Code	
<input type="checkbox"/> Check if additional changes are on reverse side			

SERIES CODE/SERIAL NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
07/13/94 18N1/1105 11/05/93				
First Named Applicant				
WARD, DAVID B.				
TITLE OF INVENTION				
METHODS OF USING LABELED NUCLEOTIDES (AS AMENDED)				

COPY

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
1	ENZ-1 (CONT'D)	435-006.000	S29	UTILITY	NO	\$1170.00 02/07/94

3. Correspondence address change (Complete only if there is a change)	4. For printing on the patent front page, list the names of not more than 3 registered patent attorneys or agents OR alternatively, the name of a firm having as a member a registered attorney or agent. If no name is listed, no name will be printed.
	1. Mary J. Morry 2. Eugene Moroz 3. Ronald C. Fedus

DO NOT USE THIS SPACE

5. ASSIGNMENT DATA TO BE PRINTED ON THE PATENT (print or type)		6a. The following fees are enclosed: <input type="checkbox"/> Issue Fee <input type="checkbox"/> Advanced Order - # of Copies (Minimum of 10)	
(1) NAME OF ASSIGNEE: YALE UNIVERSITY	(2) ADDRESS: (CITY & STATE OR COUNTY) NEW HAVEN, CONNECTICUT (3) STATE OF INCORPORATION, IF ASSIGNEE IS A CORPORATION CONNECTICUT	6b. The following fees should be changed to: DEPOSIT ACCOUNT NUMBER 05-1135 (ENCLOSED PART C)	
		XX Issue Fee XX Advanced Order - # of Copies 20 <input type="checkbox"/> Any Deficiencies in Enclosed Fees (Minimum of 10)	
		The COMMISSIONER OF PATENTS AND TRADEMARKS is requested to apply the Issue Fee to the application identified above. (Signature of party in interest of record) Ronald C. Fedus (Date) 1/19/94	
A. <input type="checkbox"/> This application is NOT assigned. <input type="checkbox"/> Assignment is being previously submitted to the Patent and Trademark Office. <input type="checkbox"/> Assignment is being submitted under separate cover. Assignments should be directed to Box ASSIGNMENTS. <b>PLEASE NOTE:</b> Unless an assignee is identified in Block 5, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the PTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.		NOTE: The Issue Fee will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the Patent and Trademark Office.	

TRANSMIT THIS FORM WITH FEE-CERTIFICATE OF MAILING ON REVERSE

## Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as ~~first~~ **EXPRESS MAIL\*** class mail in an envelope addressed to:

Box ISSUE FEE

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

on January 19, 1994

(Date)

(Signature)

Ronald C. Fedus

(Typed or Printed Name)

January 19, 1994

(Date)

Note: If this certificate of mailing is used, it can only be used to transmit the Issue Fee. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing.

EXPRESS MAIL CERTIFICATE LABEL NO. IB329026676

This form is estimated to take 20 minutes to Complete. Time will vary depending upon the needs of the individual applicant. Any comments on the amount of time you require to complete this form should be sent to the Office of Management and Organization, Patent and Trademark Office, Washington, D.C. 20231 and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, D.C. 20503.

Exhibit

II



**IN UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	David C. Ward et al.	)	
Serial No.:	07/130,070	)	Group Art Unit: 1807
Filed:	December 8, 1987	)	Examiner: Ardin Marschel, Ph.D
Title:	METHOD OF USING LABELED NUCLEOTIDES (AS AMENDED)	)	

575 Fifth Avenue (18th Floor)  
New York, New York 10017  
January 19, 1994

**FILED BY EXPRESS MAIL**

**COPY**

Hon. Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**AMENDMENT UNDER 37 C.F.R. §1.312(a)**

Dear Sirs:

Pursuant to the provisions of 37 C.F.R. §1.312(a) and MPEP §714.16, Applicants are filing this Amendment under Rule 312 in order to effect minor changes in the above-identified application. A Notice of Allowance was issued for this application on November 5, 1993, but Applicants have not yet paid the Base Issue Fee, which is concurrently submitted herewith.

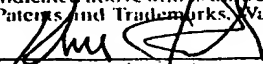
**KINDLY AMEND THIS APPLICATION AS FOLLOWS:**

**In The Specification:**

Page 1, as the first paragraph above the section "BACKGROUND OF THE INVENTION," insert the following paragraph (if not already inserted):

-- The invention disclosed and/or claimed in this application was made in the course of work carried out under grants from the Public Health Service, National Institute of General Medical Science Research Grant P50-GM20124; Public Health Service, National Cancer Institute Training Grant T32-CA09159; and Public Health Service, National Institute of General Medical Science Grant T32-GM07499. The Government has certain rights in the invention. --

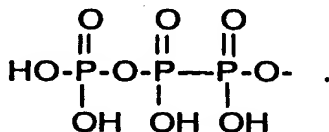
Enz-1 (Div. III)

<b>EXPRESS MAIL CERTIFICATE</b>	
"Express Mail" Label No <b>1B329026676</b>	
Deposit Date	<b>JANUARY 19, 1994</b>
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and addressed to the Commissioner of Patents and Trademarks, Washington DC 20231	
 Ronald C. Fedus Reg. No. 37 567	<b>JANUARY 19, 1994</b> Date

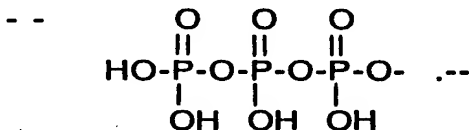
Page 1, after the "BACKGROUND OF THE INVENTION," insert the following (if not already inserted):

-- This application is a divisional of U.S. Patent Application Serial No. 06/496,915, filed on May 23, 1983, now U.S. Patent No. 4,711,955, which application was a continuation of U.S. Application Serial No. 06/255,223, filed on April 17, 1981, abandoned. --

Page 14, lines 20-22, delete



and insert therefor (if not already inserted)



Page 40, line 13, delete "andz" and substitute therefor (if not already substituted) -- and --.

*corrected with  
approval of Enz-1  
4-15-94*

~~Page 42, line 34, change (if not already changed) "(C<sub>12</sub>H<sub>17</sub>N<sub>4</sub>O<sub>13</sub>P<sub>3</sub>Na<sub>4</sub>·2H<sub>2</sub>O)"~~

~~to -- (C<sub>12</sub>H<sub>17</sub>N<sub>4</sub>O<sub>14</sub>Na<sub>4</sub>·2H<sub>2</sub>O) --~~

Page 50, line 18, delete "Microorganism" and substitute therefor (if not already substituted) -- Microorganism --.

Page 50, line 33, change (if not already changed) "whith" to -- with --.

\* \* \* \* \*

### **REMARKS**

In this Amendment Under Rule 312, Applicants are respectfully requesting that the Primary Examiner (and/or his SPE) implement minor changes for this application.

First, Applicants have inserted proper grant information on the first page (as the first paragraph) of the application, as required by 35 U.S.C. §202(c)(6) and 37 C.F.R. §6401.3(a) and 4.014(f)(4).

Second, information relating this application to previous applications in the family has also been included in the first page (after the line "BACKGROUND OF THE INVENTION").

Third, minor errors of a typographical and/or grammatical nature have been corrected on the following pages:

page 14 (lines 20-22);	page 40 (line 13);
page 42 (line 34);	page 50 (line 18); and
page 50 (line 33).	

Applicants respectfully point out that the two changes above [page 42, line 34; and page 50, line 33] were also implemented by a Certificate of Correction filed on May 25, 1990 in connection with U.S. Patent No. 4,711,955 that issued on December 8, 1987, based upon the parent application, Serial No. 06/496,515. Two other changes [page 40, line 13; and page 50, line 18], were also corrected by Applicants' Amendment Under 37 C.F.R. §1.116 and Statement Under 37 C.F.R. §§1.56 and 1.99 that was filed on June 16, 1987, also in connection with the parent application.

It is believed that the aforementioned changes to the specification will benefit the U.S. Patent and Trademark Office, including future examiners, as well as future readers of the general public who may come across the issued patent. It is respectfully submitted that no new matter will be introduced by any of the changes above, most of which were already accepted in connection with the parent application.

David C. Ward et al.

Serial No. 07/130,070

Filed: December 8, 1987

Page 4 (Amendment Under 37 C.F.R. §1.312(a) - January 19, 1994)

For the reasons stated above, therefore, Applicants and their undersigned attorney respectfully request the entry of the above amendments to the specification. It is fully understood by all that these items are not a matter of right for the Applicants - and that the Primary Examiner (and/or his SPE) can refuse their entry if so deemed.

Finally, Applicants' attorney has taken the liberty of attaching as Exhibit 1 to this Amendment a set of the allowed claims, 126-130, 134-136, 142-143, 150, 152-154, 156-157, 159-183 and 185. It is respectfully requested that the attached claims (Exhibit 1) be read for the purpose of verifying their language with that in the allowed claims as maintained in the U.S. Patent Office file(s). In particular, attention to the language in claim 150 would be sincerely appreciated, and moreover, might serve to obviate the need for any future corrections.

No fee is believed due in connection with this Amendment. If any fee is due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such fee to Deposit Account No. 05-1135.

Respectfully submitted,



Ronald C. Fedus  
Registration No. 32,567  
Attorney for Applicants

ENZO DIAGNOSTICS, INC.  
c/o Enzo Blochem, Inc.  
575 Fifth Avenue (18th Floor)  
New York, New York 10017  
Tel. (212) 856-0876

Exhibit

# POST OFFICE TO ADDRESSEE EXPRESS MAIL



NEXT DAY SERVICE

IB329026676 US

<b>ORIGIN</b>	Date: <u>11</u> / <u>01</u> / <u>91</u>	Postage: \$ <u>1.00</u>
Post Office ZIP Code: <u>10017</u>	Time In: <u>10</u> A.M. / <u>10</u> P.M.	Return Receipt \$ <u>0.00</u>
Initials of Receiving Clerk: <u>A</u>	Weight: <u>4</u> lbs. <u>0</u> oz.	C.O.D. \$ <u>0.00</u>
<b>ACCEPTANCE</b>	<input type="checkbox"/> International Country Code	
<input checked="" type="checkbox"/> Next Day Delivery <b>OR</b> <input type="checkbox"/> Second Day Delivery		
<input checked="" type="checkbox"/> By 12 Noon <b>OR</b> <input type="checkbox"/> By 3:00 P.M.		
<input type="checkbox"/> Military 2nd Day <b>OR</b> <input type="checkbox"/> Military 3rd Day		
		Total Postage & Fees \$ <u>1.00</u>

**Service Guarantee:** If this shipment is mailed at designated USPS Express Mail service facilities on or before the specified deposit time for overnight delivery to the addressee, it will be delivered to the addressee or agent before noon or 3:00 p.m. the next day upon application by the master. USPS will refund the postage for this shipment if it is not delivered before noon or 3:00 p.m. of the next day, unless delivery was attempted, but could not be made, or because this shipment was delayed by strike or work stoppage. Consult your local Express Mail directory for morning and afternoon delivery areas. See The Domestic Mail Manual, Chapter 2, for details. Signature of the addressee, addressee's agent, or delivery employee is required upon delivery. Express Mail International Service mailings are not covered by this service guarantee. See the International Mail Manual for details.

**Insurance Coverage:** (See section 295 of the Domestic Mail Manual for exclusions of coverage, such as negotiable items and consequential loss.)  
 (1) **Merchandise Insurance:** Merchandise is insured against loss, damage or rifling up to a maximum of \$500. Indemnity will not be paid for spoilage of perishable items.  
 (2) **Document Reconstruction Insurance:** Non-negotiable documents are insured against loss, damage or rifling up to \$50,000 per piece subject to a limit of \$500,000 per occurrence.  
 (3) The maximum indemnity payable for negotiable items, cash, currency or bullion is \$15.  
**Claims:**  
 • Claims for delay, loss, damage or rifling must be made within 90 days.  
 • Claim forms may be obtained and filed at any post office.  
 • The Customer Receipt must be presented when a claim is filed.

Express Mail Corporate Account No.: <u>092931</u>	Federal Agency Account No.:
<b>FROM:</b>	
RONALD C. FREDUS ENZO BIOCHEM, INC. 575 FIFTH AVENUE (18TH FLOOR) NEW YORK, NEW YORK 10017 EEE-1 (DIV. III)	

**Waiver of Signature and Indemnity (Domestic Only)**

I wish delivery to be made without obtaining the signature of the addressee or the addressee's agent (if in the judgement of the delivery employee, the article can be left in a secure location) and I authorize the delivery employee to sign that the shipment was delivered and understand that the signature of the delivery employee will constitute valid proof of delivery.

SIGNED: \_\_\_\_\_

## CUSTOMER RECEIPT

**TO:**

Telephone Number: \_\_\_\_\_

COMMISSIONER OF PATENTS  
AND TRADEMARKS  
WASHINGTON, D.C. 20231

ATTENTION: BOOK ISSUE FEE

Label 41-B (April 1990)

Thank You For Using Express Mail Service

COPY

Please date stamp and return to addressee.

<b>APPLICANT:</b> DAVID C. WARD ET AL.		<input checked="" type="checkbox"/> Express Mail Label No. IB329026676
<b>TITLE:</b> METHOD OF USING LABELED NUCLEOTIDES (AS AMENDED)		<input type="checkbox"/> First Class Mailing Date
<b>ENCLOSED ARE:</b> <input type="checkbox"/> Application <input type="checkbox"/> Declaration <input type="checkbox"/> Drawings <input type="checkbox"/> Assignment <input type="checkbox"/> Response to OA <input checked="" type="checkbox"/> Amendment UNDER 37CFR§1.312(a) <input checked="" type="checkbox"/> Issue Fee <input type="checkbox"/> Other (see below)		DATE MAILED: JANUARY 19, 1994
<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>		Serial No. 07/130,070 Docket No. ENZ-1 (DIV. III)

Please date stamp and return to addressee.

<b>APPLICANT:</b> DAVID C. WARD ET AL.		<input checked="" type="checkbox"/> Express Mail Label No. IB329026676
<b>TITLE:</b> METHOD OF USING LABELED NUCLEOTIDES (AS AMENDED)		<input type="checkbox"/> First Class Mailing Date
<b>ENCLOSED ARE:</b> <input type="checkbox"/> Application <input type="checkbox"/> Declaration <input type="checkbox"/> Drawings <input type="checkbox"/> Assignment <input type="checkbox"/> Response to OA <input checked="" type="checkbox"/> Amendment UNDER 37CFR§1.312(a) <input checked="" type="checkbox"/> Issue Fee <input type="checkbox"/> Other (see below)		DATE MAILED: JANUARY 19, 1994
<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>		Serial No. 07/130,070 Docket No. ENZ-1 (DIV. III)

